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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/692.850

10/27/2003

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Q77706

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23373 7590 01/10/2008
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EXAMINER

PHAN, JOSEPH T

ART UNIT

PAPER NUMBER

2614

MAIL DATE

DELIVERY MODE

01/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/692,850	Applicant(s) ELIAS, ERAN	
	Examiner Joseph T. Phan	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 18 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 18 is a Single Means Claim. A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. See MPEP 2164.08(a).

Line 2 recites "any one of a plurality of states" which can cover all known states in the world and therefore is not supported or enabled by the specification.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-44 rejected under 35 U.S.C. 102(b) as being anticipated by Schwartz, Patent #6,985,924.

Regarding claim 1, Schwartz teaches a user client(Fig.2) for a communication device(16 Fig.2), said user client being able to assume a number of different states(16a Fig.3), said communication device(16 Fig.3 and col.6 lines 13-47) operable to communicate with a remotely located media based network service(20 Fig.2), the user client comprising: a communication module(10 Fig.2) for causing said communication device to communicate information representing a currently assumed one of said states to a remotely located network system(22,24,25 of Fig.2) so as to enable control thereof according to said currently assumed state(col.7 lines 3-49 and col.8 lines 46-59).

Regarding claim 2, Schwartz teaches the user client of claim 1, further comprising said remotely located network system, wherein said remotely located network system is in communication with said user client, and wherein said remotely located media based network service comprises a voicemail system(col.4 lines 43-61 and D1 Fig.4; a 'voicemail system').

Regarding claim 3, Schwartz teaches the user client of claim 1, further comprising said remotely located network system, wherein said remotely located network system is in communication with said user client, and wherein said remotely located media based network service comprises a video based system(col.5 lines 59-64 or col.6 lines 15-20).

Regarding claim 4, Schwartz teaches the user client of claim 2, wherein a plurality of prerecorded greetings are available for interoperation with said user client at said remotely located network and wherein control of said remotely located media based network comprises selection of one of said greetings in accordance with the currently assumed state, and said control further comprising causing the selected greeting to be played back as a voicemail reply from said remotely located voicemail system to a calling party(Fig.2 and E9 Fig.14 and col.7 lines 3-49).

Regarding claim 5, Schwartz teaches the user client of claim 4, wherein said communication module comprises a data messaging protocol(col.3 lines 31-65).

Regarding claim 6, Schwartz teaches the user client of claim 4, further comprising a module for presenting to a user, upon receipt of an incoming call, an ability to select one of said different states instead of answering said call(Fig.2 and E9 Fig.14 and col.7 lines 3-49).

Regarding claim 7, Schwartz teaches the user client of claim 6, wherein said communication module is configurable according to a selected one of said states to communicate said selected state to the voicemail system so as to cause said voicemail to select a greeting corresponding to the selected state(Fig.2 and E9 Fig.14 and col.7 lines 3-49).

Regarding claim 8, Schwartz teaches the user client of claim 6, wherein said module is configured such that said communication device is operable to present a plurality of different greetings for user selection therefrom, each state being associated with a different one of said greetings(16a Fig.3, E9 Fig.14 and col.7 lines 1-49).

Regarding claim 9, Schwartz teaches the user client of claim 4, wherein said user client is switchable substantially at any time between said states, and wherein said communication module is configured to communicate to said voicemail system an exchange of states so as to

enable said voicemail system to select a voicemail greeting according to said current state(16a Fig.3, E9 Fig.14 and col.7 lines 1-49).

Regarding claim 10, Schwartz teaches the user client of claim 4, further comprising a user input for allowing a user to define at least one of said states and to associate a different greeting with each of said states(E9 Fig.14 and col.7 lines 1-49).

Regarding claim 11, Schwartz teaches the user client of claim 10, further comprising a user input for allowing a user to record a greeting for association with one of said states(106 Fig.4, E9 Fig.14, and col.7 lines 3-49).

Regarding claim 12, Schwartz teaches the user client of claim 4, wherein one of said states is a real time recording mode enterable upon receipt of a call at said communication device, said user client further comprising a user interface for enabling a user to record in real time a new greeting upon receipt of said call(106 Fig.4, col.8 lines 49-59, col.14 lines 60-67, and col.15 lines 30-42).

Regarding claim 13, Schwartz teaches the user client of claim 12, wherein said real time recording mode is configured so as to carry out said recording of the new greeting whilst delaying forwarding of said call from said communication device to said voicemail system(col.8 lines 49-59, col.14 lines 60-67, and col.15 lines 30-42).

Regarding claim 14, Schwartz teaches the user client of claim 12, wherein said real time recording mode is configured to forward said recorded greeting as at least one voice packet to said voicemail system for playing as said reply(col.8 lines 49-59, col.14 lines 60-67, and col.15 lines 30-42).

Regarding claim 15, Schwartz teaches the user client of claim 14, wherein said

communication module is configured to communicate said voicemail greeting, together with control data for said voicemail system, using voice packets(col.8 lines 49-59, col.14 lines 60-67, and col.15 lines 30-42).

Regarding claim 16, Schwartz teaches the user client of claim 4, further comprising a user interface for allowing a user to select between (1) a menu of predefined voicemail greetings; and (2) recording a new voicemail greeting(106 Fig.4, col.8 lines 49-59, col.14 lines 60-67, and col.15 lines 30-42).

Regarding claim 17, Schwartz teaches the user client of claim 4, wherein said communication device is a mobile communication device(Fig.3).

Regarding claim 18, Schwartz teaches a communication device comprising a user client, said user client being operable to configure said communication device into any one of a plurality of states and further to configure said communication device for communication with a remotely located voicemail system so as to apply settings to said voicemail system(Fig.2 is a 'voicemail system', col.7 lines 3-49 and col.8 lines 46-59).

Regarding claim 19, Schwartz teaches the communication device of claim 18, wherein said applying settings comprises selection of a voicemail reply greeting by said remotely located voicemail system in accordance with a current state of said communication device(col.7 lines 3-49 and col.8 lines 46-59).

Regarding claim 20, Schwartz teaches the communication device of claim 18, further comprising a data messaging module for communicating with said remotely located voicemail system(Fig.2, col.7 lines 3-49 and col.8 lines 46-59).

Regarding claim 21, Schwartz teaches the communication device of claim 19, further

comprising a communication module configured to communicate to said remote voicemail system any change in state at said communication device so as to control said voicemail system to provide a voicemail greeting according to said current state(Fig.4, col.7 lines 3-49 and col.8 lines 46-59).

Regarding claim 22, Schwartz teaches the communication device of claim 19, wherein said user client is configured into one of said plurality of states by the user selecting a predefined greeting from a menu of predefined greetings at said communication device(Fig.3).

Regarding claim 23, Schwartz teaches the communication device of claim 19, wherein said user client is configured into one of said plurality of states by the user selecting between (1) a menu of predefined greetings and (2) recording of a new greeting(106 Fig.4, col.8 lines 49-59, col.14 lines 60-67, and col.15 lines 30-42).

Regarding claim 24, Schwartz teaches the communication device of claim 19, wherein one of said states is a real time recording state enterable upon receiving a call from a caller, and wherein said real time state permits a user to record a greeting in real time and to send said recorded greeting to said voicemail system for playback as the voicemail greeting to said caller(106 Fig.4, col.8 lines 49-59, col.14 lines 60-67, and col.15 lines 30-42).

Regarding claim 25, Schwartz teaches the communication device of claim 24, wherein the device is operable to record the greeting in real time whilst delaying forwarding of said call from said communication device to said voicemail system(106 Fig.4, col.8 lines 49-59, col.14 lines 60-67, and col.15 lines 30-42).

Regarding claim 26, Schwartz teaches the communication device of claim 24, wherein the device is operable to forward said recorded greeting as at least one voice packet, together

with control data, to said voicemail system for playback as the voicemail reply(106 Fig.4, col.8 lines 49-59, col.14 lines 60-67, and col.15 lines 30-42).

Regarding claim 27, Schwartz teaches the communication device of claim 18, wherein the communication device is a mobile communication device(fig.3).

Regarding claim 28, Schwartz teaches the communication device of claim 21, wherein said plurality of possible states comprises at least one user definable mode, said user client comprising a user interface for defining of said user definable mode(106 Fig.4, col.8 lines 49-59, col.14 lines 60-67, and col.15 lines 30-42).

Regarding claim 29, Schwartz teaches the communication device of claim 21, wherein said plurality of possible states comprises at least one user selectable mode, said user client comprising a user interface for user selecting of said mode(106 Fig.4, col.8 lines 49-59, col.14 lines 60-67, and col.15 lines 30-42).

Regarding claim 30, Schwartz teaches a server-based subscriber service system(Fig.2) comprising: an output unit for outputting selected content, and a content selection unit(Fig.3-4), associated with said media output unit for using data representing a current state of a called party handset to select said content for output by said output unit(Fig.3 and E9 Fig.14, col.8 lines 49-59, col.14 lines 60-67, and col.15 lines 30-42).

Regarding claim 31, Schwartz teaches the server-based subscriber service system of claim 30, wherein said media content is a voicemail greeting(Fig.3 and E9 Fig.14, col.8 lines 49-59, col.14 lines 60-67, and col.15 lines 30-42).

Regarding claim 32, Schwartz teaches the server-based subscriber service system of claim 30, further comprising a data communication unit associated with said content selection

unit for receiving state data from said called party handset from which to determine said current state(Fig.3 and E9 Fig.14, col.8 lines 49-59, col.14 lines 60-67, and col.15 lines 30-42).

Regarding claim 33, Schwartz teaches the server-based subscriber service system of claim 30, wherein said current state is a real time record state, and further comprising a module operable to receive a real time recorded item for immediate output as said selected item(Fig.3 and E9 Fig.14, col.8 lines 49-59, col.14 lines 60-67, and col.15 lines 30-42).

Regarding claim 34, Schwartz teaches the server-based subscriber service system of claim 32, wherein said communication unit is operable to receive said state data in at least one of SMS format and USSD format(col.3 lines 31-65 and Table 2 in col.11).

Regarding claim 35, Schwartz teaches the server-based subscriber service system of claim 32, wherein said data communication unit is operable to use the push-to-talk protocol to enable receipt of said content together with said state data(Fig.2 and Fig.3).

Regarding claim 36, Schwartz teaches the server-based subscriber service of claim 32, wherein said content is video, and said communication unit is operable to use the Push-to-Show protocol to enable receipt of said video item(Fig.2 and Fig.3).

Regarding claim 37, Schwartz teaches a method of providing remote control to a server-based subscriber service comprising: using a media channel to receive media content for use in said subscriber service, using a data channel to receive data concerning said media content(col.4 lines 22-60), and using said received data to select, from said received media content, a content item for use in said subscriber service(Fig.3 and E9 Fig.14; display options is media content that the data is selected from).

Regarding claim 38, Schwartz teaches the method of claim 37, wherein said received data

comprises data received with said media content and data received subsequent to said media content(Fig.3 and E9 Fig.14; display options is media content that the data is selected from).

Regarding claim 39, Schwartz teaches a handset and server based greeting system comprising: a user handset(Fig.3), and a server based greeting system located remotely from said handset over a communication network(Fig.2), wherein said server based greeting system comprises: a memory for storing a plurality of greetings associated with a given user handset(32 Fig.2) and; a selector for selecting one of said greetings as a current greeting for playing to a rejected call forwarded from said handset; and wherein said handset comprises a message communication module for communicating to said server based greeting system an indicator for instructing said selector to select a given greeting as said current greeting(Fig.3, 106 Fig.4, col.7 lines 3-49 and col.8 lines 46-59).

Regarding claim 40, Schwartz teaches the handset and server based greeting system of claim 39, wherein said message communication module is further configured to communicate to said server based greeting system an indicator to accept a greeting presently being recorded at said handset as said current message(106 Fig.4, col.8 lines 49-59, col.14 lines 60-67, and col.15 lines 30-42).

Regarding claim 41, Schwartz teaches a handset and server based greeting system comprising: a user handset(Fig.3), and a server based greeting system located remotely from said handset over a communication network(Fig.2), and wherein said server based greeting system comprises a memory for storing at least one greeting associated with a given user handset(32 Fig.4). and wherein said handset comprises a message communication module for

communicating to said server based greeting system:

- 1) a rejection of a current incoming call(16a Fig.3) and
- 2) an indicator for instructing said selector to select a greeting presently being recorded at said handset as said current message, thereby to allow a realtime recorded greeting to be played as a voicemail greeting to said current incoming call(Fig.14, col.8 lines 49-59, col.14 lines 60-67, and col.15 lines 30-42).

Regarding claim 42, Schwartz teaches a user client and server based greeting system(10 Fig.2) comprising: a user client(20 Fig.2) for a user handset(16 Fig.2), and said server based greeting system located remotely from said handset over a communication network(22,24,25 Fig.2), wherein said server based greeting system comprises:

a memory for storing a plurality of greetings associated with a given user handset (32 Fig.2) and; a selector for selecting one of said greetings as a current greeting for playing to a rejected call forwarded from said handset; and wherein said user client comprises a message communication module for communicating to said server based greeting system an indicator for instructing said selector to select a given greeting as said current greeting(16a Fig.3, E9 Fig.14, col.8 lines 49-59, col.14 lines 60-67, and col.15 lines 30-42).

Regarding claim 43, Schwartz teaches the user client and server based greeting system of claim 42, wherein said message communication module is further configured to communicate to said server based greeting system an indicator to accept a greeting presently being recorded at said handset as said current message(106 Fig.4, col.8 lines 49-59, col.14 lines 60-67, and col.15 lines 30-42).

Regarding claim 44, Schwartz teaches a user client and server based greeting system

comprising: a user client(20 Fig.2) for a user handset(16 Fig.2), and a server based greeting system located remotely from said handset over a communication network(10 Fig.2), and wherein said server based greeting system comprises a memory for storing at least one greeting associated with a given user handset(32 Fig.2) and wherein said user client comprises a message communication module(22a-24a/b Fig.2) for communicating to said server based greeting system:

- 1) a rejection of a current incoming call(16a Fig.3) and
- 2) an indicator for instructing said selector to select a greeting presently being recorded at said handset as said current message, thereby to allow a realtime recorded greeting to be played as a voicemail greeting to said current incoming call(col.8 lines 49-59, col.14 lines 60-67, and col.15 lines 30-42).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. Brown et al., Patent #7,224,774 teaches a real-time call control system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T. Phan whose telephone number is (571) 272-7544. The examiner can normally be reached on Mon-Fri 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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JTP

January 2, 2008



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